

REMARKS

This application pertains to a redetachable self-adhesive film strip, having a grip tab which has a static frictional force  $F_s$ , as measured in accordance with DIN 53375, of at least 170 cN. Owing to the frictional force, the grip tabs can be held more securely when pulled on to stretch the adhesive film strip to break the adhesive bond.

Claims 1, 3, 5-7, 9 and 10 are pending, claim 8 being cancelled by this amendment. The limitations of claim 8 have been incorporated into claim 1.

Claim 1, 3, 5 and 10 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al. '012. The Examiner sees in the Lühmann reference what appears to him to be a substantially identical adhesive film strip having a grip tab made from the same materials as those of the present invention. The Examiner contends that the static frictional forces would be inherent.

As previously pointed out, the Examiner has not identified any evidence in the reference cited that would support his contention that the static frictional forces would be inherent.

In this regard, it is respectfully pointed out that if the Examiner relies on a theory of inherency as to any particular element, then the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir.

1999). Further, inherency is not established by probabilities or possibilities, and the mere fact that a property may result from a given circumstances is not sufficient; instead it must be shown that such property *necessarily* inheres in the thing described in the reference.

Nothing has been shown that would indicate that the grip tabs of the Lühmann reference would *inherently* have the static frictional force claimed by Applicants. The Examiner appears to base his conclusion on the disclosure in the Lühmann reference of the use of a UV Opaque covering on the ends of his adhesive strips, which can be used as grip tabs, in combination with Applicants' own comments at page 6, line 2, that the corresponding DE '849 possesses "particularly suitable grip tab regions".

First of all, nothing is taught or suggested in Lühmann about increasing the static friction force of the grip tabs to at least 170 cN. Secondly, the Examiner appears to be misreading the statement made by Applicants at page 6, lines 1-3. The referenced statement clearly indicates that the regions of the grip tabs of the references mentioned in the statement would be suitable locations where Applicants' grip tabs could be placed. More specifically, these are positions on the adhesive film strips where Applicants' novel grip tabs could be placed.

Lühmann '012, whether read alone or in combination with the statement at the top of page 6 of Applicants' specification neither teaches nor suggests the claimed adhesive film strips, having grip tabs which have been treated to increase their static friction force to at least 170 cN.

Applicants also note that the grip tabs of the Lühmann '932 reference are formed by using laminations to apply grip tabs in the grip regions of Lühmann's strips. However, Lühmann '932 laminates the grip tabs with e.g. plastics, metal foils and papers, *which either have per se a sufficiently low adhesion to the adhesive composition or are coated with an appropriate release coating* (Lühmann '932, col. 2, lines 30-36).

There is absolutely nothing in Lühmann '932 that would teach or suggest doing anything at all to increase the static frictional force of the grip tabs.

Applicants, by contrast, coat, etch, grind or emboss their grip tabs to increase their static friction force. This concept is completely foreign to and not in any way suggested by either of the Lühmann references.

With respect to the Examiner's comment that Applicants' illustration of two different silicone varnishes having markedly different static frictional forces is not recited in the claims, Applicants would respectfully point out that this illustration was never intended to be a limitation of the claims. The only point being made by Applicants was that silicones can have markedly different static frictional forces, and the mere fact that the word "silicone" can be found in the Lühmann reference does not teach or suggest anything about increasing the static friction force of a grip tab.

In order to more clearly distinguish their claims from anything that could be found in either Lühmann reference, Applicants' claims have now been amended to specifically recite that the grip tabs are acted upon to increase their static friction force to at least 170 cN. Clearly, Lühmann does not so act upon his grip tabs.

Support for this limitation can be found at page 3, line 31 through page 4, line 19.

In view of the foregoing amendments and comments, it should be clear that Applicants' claims are neither anticipated nor suggested by the Lühmann '012 reference, and the rejection of claims 1, 3, 5 and 10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lühmann et al. '012 should now be withdrawn.

Claims 6-9 stand rejected under 35 U.S.C. 103(a) as obvious over Lühmann '012, taken either individually or in view of Lühmann '932.

The Examiner basis his finding of obviousness on his conclusion that the deformable or low tack compositions of Lühmann '012 and/or the silicone release agents listed on the table in Lühmann '932 are suggestive of Applicants' grip tabs having a static friction force of at least 170 cN. The Examiner contends that Applicants' did not traverse the Examiner's contention that such parameters as coating a grip tab with either deformable or low tack compositions, such as silicones, are well known.

Applicants did and do traverse the Examiner's contention that any known coating of grip tabs, especially those of the Lühmann reference, could possibly render Applicants' claims obvious. Applicants previously pointed out that different silicones have different static friction forces, and nothing in Lühmann teaches or suggests that his release agents would increase the static friction force of the substrate being coated. Note that in Applicants' test data, at page 7 of the specification, that only Applicants special silicone varnish B meets the required static

friction force requirements of Applicants' claims, whereas silicone varnish A did not even come close.

If the Examiner should continue to argue that the silicone release agents of the Lühmann references somehow increase the static friction force of a substrate to 170 cN, he is respectfully asked to point to some language in the references that say this.

Clearly, neither Lühmann reference, whether taken individually or in combination, teach or suggest anything about treating a grip tab to increase its static friction force to at least 170 cN.

The rejection of claims 6-9 stand under 35 U.S.C. 103(a) as obvious over Lühmann '012, taken either individually or in view of Lühmann '932 should accordingly now be withdrawn.

In view of the present amendments and remarks, it is believed that claims 1, 3, 5-7 and 9-10 are now in condition for allowance. Reconsideration of said claims by the Examiner is respectfully requested, and the allowance thereof is courteously solicited. Should the Examiner not deem the present amendment and remarks to place the instant claims in condition for allowance, it is respectfully requested that this Amendment Under Rule 116 be entered for the purpose of placing the prosecution record in better condition for appeal.